

REMARKS

Claims 1-6 and 8-18 are currently pending in this application and have been examined on the merits. All pending claims are rejected as follows:

- (a) Claims 1-6, 8 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) in view of Moltrasio (US 5,075,366);
- (b) Claims 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Moltrasio, further in view of Nito (US 6,932,465);
- (c) Claims 12 and 13 rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Moltrasio in view of Nito, further in view of Arnaud (US 2004/002840);
- (d) Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Moltrasio, further in view of Bergomi (US 3,665,060);
- (e) Claims 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Moltrasio, further in view of Isenberg (US 2,389,781).

Applicants have considered the rejections at length but respectfully disagree. In view of the arguments laid out below, Applicants submit that the claimed subject matter is not rendered obvious by the cited references. Favorable reconsideration and allowance of the claims are earnestly solicited.

Rejections under 35 USC § 103(a) – Obviousness

All pending claims 1-6 and 8-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Moltrasio, and further in view of additional references, including Nito, Arnaud, Bergomi and Isenberg. Applicants respectfully traverse. To avoid

redundancy, Applicants incorporate by reference their arguments regarding Iwase, Nito, Arnaud, Bergomi and Isenberg in their May 5, 2009 Response.

As a preliminary matter, none of Iwase, Opre, Nito, Arnaud, Bergomi, or Isenberg teaches “an *offset printing ink or varnish* wherein the *solvent* comprises at least one water-insoluble ester of a *polycarboxylic acid having more than 2 carboxylic acid groups* with a monohydric alcohol having at least 4 carbon atoms” as recited in independent claim 1.

Specifically, Iwase teaches an offset printing ink comprising a solvent containing diester compound of the aliphatic dibasic acid. (Iwase at abstract and paragraph [0013]). Iwase does not teach an “ester of a polycarboxylic acid having more than 2 carboxylic acid groups.”

The Examiner alleged that “Moltrasio teaches the use of an ester of citric, acetylcitric or tartaric acid in a masterbatch to be used as a printing ink (abstract, background).” (Office Action, at p. 2). Applicants respectfully disagree. Moltrasio alleges that the masterbatch may be used in printing inks in the abstract and background. However, all examples in Moltrasio are directed to masterbatches to be used in resin-based paints, plastic materials and even natural rubber, but none of the examples even suggested use in printing inks. (See Moltrasio at examples 1-6). Moreover, Moltrasio does not teach or suggest that masterbatches can be used in “an offset printing ink or varnish” as recited in independent claim 1.

A person of skill in the art understands that masterbatches are concentrated mixture of pigments and/or additives encapsulated during a heat process into a carrier resin which is then cooled and cut into a granular shape – in other words, in solid form. For example, Moltrasio teaches that “A powder is thus obtained, which is put into a bifilar extruder and extruded at a temperature of between 90° and 150 °C. At the exit of the extruder a cutter is provided which cuts the extruded mix into pellets of desired sizes.” A person of skill in the art understands that any component used in such masterbatches may not be suitable to be used as a solvent for an

offset printing ink or varnish. In fact, the citric or tartaric acid mono-alcohol esters of Moltrasio is always used “in admixture with polyalkyleneglycols containing between 10 and 30 monomeric units,” making component b) in Moltrasio even more unsuitable to be used as a solvent for an offset printing ink or varnish.

Therefore, none of the cited prior art, including Iwase and Moltrasio, teaches an “offset printing ink or varnish wherein the solvent comprises at least one water-insoluble ester of a polycarboxylic acid having more than 2 carboxylic acid groups” as solvent, in printing ink or not in printing ink. Iwase specifically teaches diesters whereas Moltrasio teaches masterbatches in solid form. A person of skill in the art understands that what is taught in Moltrasio is not suitable to be used in an offset printing ink or varnish. Unlike what the Examiner alleged, it would **not** have been obvious for a person skilled in the art to combine the teachings of Iwase and Moltrasio to create the present invention. *See* MEPE § 2141 (“The gap between the prior art and the claimed invention may not be ‘so great as to render the [claim] nonobvious to one reasonably skilled in the art.’” Quoting *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976)).

For a rejection of obviousness, a reasonable expectation of success in combining the teaching of references is ***required***. *See* MPEP 2143.02; *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 82 USPQ2d 1385, 1395 (2007); *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir. 1991). Applicants respectfully submit that a person of ordinary skill in the art would not have a reasonable expectation of success in combining the teaching of Iwase and Moltrasio, Nito, Arnaud, Bergomi or Isenberg to reach the present invention as claimed.

Accordingly, Iwase, in view of Moltrasio, Nito, Arnaud, Bergomi, or Isenberg, does not render the pending claims obvious. Withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

Applicants submit that all of the pending claims are now in condition for allowance and a Notice to that effect is solicited. If this *Response to Office Action* does not otherwise result in the issue of such Notice, the Examiner is urged to contact Applicants' undersigned counsel for discussion.

No fee, other than the fee associated with the Petition for a One-Month Extension of Time submitted concurrently herewith, is believed to be due for the filing of this Response to Office Action. However, the Director is hereby authorized to charge all fees due, and credit any overpayments, to Deposit Account No. 50-0540.

Respectfully submitted,

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